

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appln. No: 10/017,965  
Applicant: M. Oshima et al.  
Filed: December 7, 2001  
Title: MARK FORMING APPARATUS, METHOD OF FORMING LASER  
MARK ON OPTICAL DISK, REPRODUCING APPARATUS, OPTICAL  
DISK AND METHOD OF PRODUCING OPTICAL DISK  
TC/A.U.: 2137  
Confirmation: 8891  
Examiner: Paul E. Callahan

**SUPPLEMENTAL**  
**INFORMATION DISCLOSURE STATEMENT**

**Mail Stop AF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §§ 1.97 and 1.98 and to the duty of disclosure set forth in 37 C.F.R. § 1.56, the Examiner in charge of the above-identified application is requested to consider and make of record the references listed on the PTO 1449 (RP) submitted herewith. A copy of the references listed on the 1449 form is enclosed.

Although the information submitted herewith may be "material" to the Examiner's consideration of the subject application, this submission is not intended to constitute an admission that such information is "prior art" as to the claimed invention.

In accordance with 37 C.F.R. § 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made.

The following reference is not in the English language:

1) JP 01-243237

Reference 1) includes an English language abstract and was cited by a foreign patent examining authority in connection with the examination of a counterpart of the above identified application. A copy of this English language search

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report, indicating the degree of relevance determined by the foreign patent office is submitted herewith. MPEP 609 IIIA(3), second paragraph.

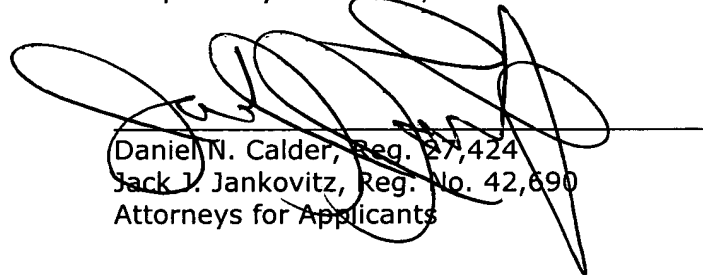
A copy of Reference US 5,050,150 was cited in an Information Disclosure Statement filed December 7, 2001, and a copy of Reference EP 0549488 was cited in an Information Disclosure Statement filed May 23, 2003.

**STATEMENT UNDER 37 C.F.R. § 1.97(e)**

The undersigned hereby states that each item of information contained in the Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the Information Disclosure Statement.

The required fee set forth in 37 C.F.R. § 1.17(p) is provided herewith.

Respectfully submitted,



Daniel N. Calder, Reg. No. 27,424  
Jack J. Jankovitz, Reg. No. 42,690  
Attorneys for Applicants

JJJ/fp

Enclosures: PTO Form 1449 (2 sheets)  
(#2) References  
European Search Report  
Transmittal Form  
Fee Transmittal  
Credit Card Payment Form (\$180)

Dated: October 20, 2004

P.O. Box 980  
Valley Forge, PA 19482  
(610) 407-0700

The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. **18-0350** of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

October 20, 2004



OCT 22 2004

*(Use as many sheets as necessary)*

**SHEET 1 of 2**

**Complete if Known**

Application Number	<b>10/017,965</b>
Filing Date	<b>December 7, 2001</b>
First Named Inventor	<b>Mitsuaki OSHIMA, et al.</b>
Art Unit	<b>2137</b>
Examiner Name	<b>Paul E. Callahan</b>
Attorney Docket No.	<b>MTS-520US4</b>

## U.S. PATENT DOCUMENTS

[illegible]

## FOREIGN PATENT DOCUMENTS

[illegible]

Examiner Signature		Date Considered	
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

<sup>1</sup>Applicant's unique citation designation number (optional).

<sup>2</sup>See Kind Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04.

<sup>3</sup>Enter Office that issued the document, by the two-letter code (WIPO Standard St.3).

<sup>4</sup>For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

<sup>5</sup>Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible.

<sup>6</sup>Applicant is to place a check mark here if English language translation is attached.

The collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

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Substitute for Form 1449B/PTO

# INFORMATION DISCLOSURE STATEMENT BY APPLICANT

*(Use as many sheets as necessary)*

**Complete if Known**

Application Number	<b>10/017,965</b>
Filing Date	<b>December 7, 2001</b>
First Named Inventor	<b>Mitsuaki OSHIMA, et al.</b>
Art Unit	<b>2137</b>
Examiner Name	<b>Paul E. Callahan</b>
Attorney Docket No.	<b>MTS-520US4</b>

**SHEET 2 of 2**

## NON-PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T <sup>2</sup>
		European Search Report for EP 04020082, dated October 6, 2004.	<input type="checkbox"/>
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Examiner Signature		Date Considered	

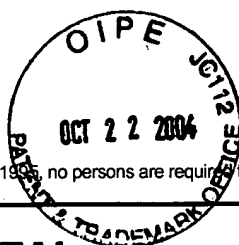
\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

<sup>1</sup>Applicant's unique citation designation number (optional).

<sup>2</sup>Applicant is to place a check mark here if English language translation is attached.

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PTO/SB/21 (02-04) (AW 02/2004)  
Approved for use through 7/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

2137#  
B/92

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission 4 + 2 refs. +  
European Search Report

Application Number	10/017,965
Filing Date	December 7, 2001
First Named Inventor	M. Oshima et al.
Art Unit	2137
Examiner Name	Paul E. Callahan
Attorney Docket No.	MTS-520US4

### ENCLOSURES (Check all that apply)

- ☒ Fee Transmittal Form
- ☒ Fee Attached
- ☐ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/Declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☒ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/  
Incomplete Application
- ☐ Response to Missing Parts under  
37 CFR 1.52 or 1.53

- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a  
Provisional Application
- ☐ Power of Attorney, Revocation,  
Change of Correspondence  
Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) \_\_\_\_\_

- ☐ After Allowance Communication  
to Group
- ☐ Appeal Communication to Board  
of Appeals and Interferences
- ☐ Appeal Communication to Group  
(Appeal Notice, Brief, Reply  
Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please  
identify below):
  - > Return postcard
  - > 2 references
  - > PTO Form 1449
  - > European Search Report
  - > Credit Card Payment Form

Remarks:

### SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm or Individual Name	Jack J. Jankovitz	Registration No. (Attorney/Agent)	42,690
Signature			
Date	October 20, 2004		

### CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date:

Typed or printed name	Fran Petrillo
Signature	
Date	October 20, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Office, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, ALEXANDRIA, VA 22313-1450.

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# FEE TRANSMITTAL

**for FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT (\$)** **180.00**

## Complete if Known

Application Number **10/017,965**  
Filing Date **December 7, 2001**  
First Named Inventor **Mitsuaki OSHIMA, et al.**  
Examiner Name **Paul E. Callahan**  
Art Unit **2137**  
Attorney Docket No. **MTS-520US4**

## METHOD OF PAYMENT (check all that apply)

☐ Check ☒ Credit Card ☐ Money ☐ Other ☐ None  
Order

☒ Deposit Account (use as backup only):

Deposit  
Account  
Number

**18-0350**

Deposit  
Account  
Name

**RatnerPrestia**

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below  
☒ Credit any overpayments  
☒ Charge any additional fee(s) or any underpayment of fee(s)  
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	790	2001	395	Utility filing fee	
1002	350	2002	175	Design filing fee	
1003	550	2003	275	Plant filing fee	
1004	790	2004	395	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					<b>(\$)</b> <b>0</b>

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

			Extra Claims	Fee from below	Fee Paid
Total Claims		-20**	=	<b>18.</b>	= <b>0</b>
Independent Claims		-3**	=	<b>88.</b>	= <b>0</b>
Multiple Dependent			X	<b>300.</b>	= <b>0</b>

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	88	2201	44	Independent claims in excess of 3
1203	300	2203	150	Multiple dependent claim, if not paid
1204	88	2204	44	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) **(\$)** **0.**

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	430	2252	215	Extension for reply within second month	
1253	980	2253	490	Extension for reply within third month	
1254	1,530	2254	765	Extension for reply within fourth month	
1255	2,080	2255	1,040	Extension for reply within fifth month	
1401	340	2401	170	Notice of Appeal	
1402	340	2402	170	Filing a brief in support of an appeal	
1403	300	2403	150	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,370	2453	685	Petition to revive - unintentional	
1501	1,370	2501	685	Utility issue & publication fees (or reissue)	
1502	490	2502	245	Design issue fee	
1503	660	2503	330	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	<b>180.</b>
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) )

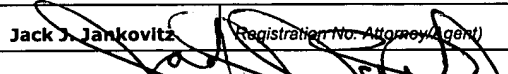
\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

**(\$)** **180.**

## SUBMITTED BY

## Complete (if applicable)

Name (Print/Type)	<b>Jack J. Jankovitz</b>	Registration No. Attorney/Agent	<b>42,690</b>	Telephone	<b>(610) 407-0700</b>
Signature		Date	<b>October 20, 2004</b>		

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